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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/369,502	08/05/1999	FOROUGH KASHEF	VISAP018/P10	6864

22434 7590 03/05/2003

BEYER WEAVER & THOMAS LLP
P.O. BOX 778
BERKELEY, CA 94704-0778

EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/369,502

Applicant(s)

KASHEF ET AL.

Examiner

Ahshik Kim

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/12/02 (Preliminary Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 04/17/00 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12,17-19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Prosecution Application

1. The request filed on August 7, 2002 for a Continued Prosecution Application (CPA)
5 under 37 CFR 1.53(d) based on parent Application No. 09/369,502 is acceptable and a CPA has
been established. An action on the CPA follows.

Preliminary Amendment

2. Receipt is acknowledged of the preliminary Amendment filed on September 12, 2002.
10 Claims 1-36 remain for examination.

Drawings

3. This application has been filed with informal drawings which are acceptable for
examination purposes only. Formal drawings will be required when the application is allowed.
15

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

- 20 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
manner in which the invention was made.

- 25 This application currently names joint inventors. In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

5 and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eaton et al. (US 6,012,050, of record), in view of Wilkinson et al. (WO 98/19237, of record).

Eaton teaches a transaction system that utilizes an ATM terminal 93, the system
10 comprising an operating system and terminal hardware and an environmental services layer L4 that is dependent upon the operating system and/or hardware. The layers, labeled collectively as the Integrated Channel Manager 100, contains applications to select and activate environment dependent services 92-97, the applications independent from the hardware or operating system and allowing multiple channels to be accessed (see figures 2-4, col. 4, line 5 – col. 5, line 8).
15 The environmental dependent services may consist of any combination of structures, affording the possibility of identical structures. Interfaces 132, 134, 136 allow the applications to identify an environmental dependent services layer. A business logic layer (item 130 of figure 3) contains interfaces 122,124,126 and modules 142,144,146,148 that are responsible for executing business application commands and functions. Layer L6 provides services that enable peripheral
20 devices to be accessed (col. 4, lines 66-67). Multimedia services can also be accessed, those including a user interface or printing means (col. 6, lines 27-34). The system may be used as a loyalty card service.

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Eaton fails to teach the terminal application as compatible with a smart card, the card's information able to use different modules or applications, and the terminal application as portable to a plurality of terminals.

Wilkinson teaches using a smart card 10 to control communication with a terminal, the
5 card being recognized and identified by the terminal application when presented to the card reader (see figure 13 and page 24, line 14 – page 25, line 4) and supplying applications to be used within the terminal. The card contains multiple card applications. The applications utilized may be provided by different companies using different terminals (page 6, line 33 – page 7, line 1). It would have been obvious to one of ordinary skill in the art to employ the use of the card
10 with the system of Eaton. It is well known in the art to use cards to transport data from one card-reading terminal to another. The data containing different applications would afford the terminal of Eaton to become more versatile in the types of transactions it can handle. This also allows different terminals to employ similar applications, as the card would be readily portable and available to operate successfully with the terminal.

15 Although the teachings do not specify the business layer implementing business policies if the card is not recognized, it would have been obvious to employ such a feature within the system. Official Notice is taken that it is known in the art for terminals of financial institutions to implement features if, per se, the card of a user is not recognized. For instance, if a customer is trying access funds with the card at a terminal, but the card is not recognized, the terminal
20 applications with enable certain business policies, such as asking for other types of account identifiers or penalizing an account for using an incorrect card.

Response to Remarks

5. With amended claims and arguments, the Applicant traverses 35 U.S.C. 103 rejection mentioned in above paragraph. Particularly in third paragraph on page 14, the Applicant argues that blocks 111-115 are external data sources and operating means. Upon further review of the

5 Eaton patent, it appears that various interfaces 92-97 for the customer to perform transaction comprise an environment services layer and a terminal application. It is the Examiner's view that each terminal is inherently equipped with some protocols and applications - an environment services layer - which enables particular interface device (i.e., phone, ATM, PC terminal, etc.) to be operational.

10 As further shown in figure 5 (col. 6, lines 13+), each terminal can be grouped as inner region 505 which includes Presentation 506. The terminals works in coordination with the middle layers 502 and 503 (col. 6, lines 65+), which are written with platform-independent language such as C/C++ (col. 7, lines 44+).

The Eaton patent also discloses that the system may be used in retail system, which may
15 include loyalty/membership award system (col. 6, lines 1-12).

Conclusion

20 I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Peyret et al. (US 5,923,884); Teicher (US 6,065,675); Korman et al. (US 6,308,887); Raz (US 6,292,827); Elliott et al. (US 5,036,461) disclose a system accepting various smart cards.

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203 . The

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examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

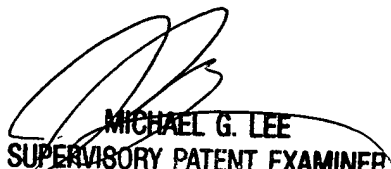
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Ahshik Kim
Patent Examiner
Art Unit 2876
February 24, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800